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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE CARGILE, DAVID KESSELMAN, and ROY KROHN

Appeal 2008-0552
Application 10/662,878
Technology Center 3700

Decided: May 30, 2008

Before TERRY J. OWENS, JENNIFER D. BAHR, and LINDA E.
HORNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dave Cargile et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1 through 22. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

The Appellants' invention is directed towards a tube 10 for storing a product to be squeezed from the tube using a wrapping tool 20 (Spec. 1, ¶ 4 and figs. 5 and 6). The tube 10 includes a deformable main body 100, an opening 210, a seal 300, and a contour 310 that provides surfaces that facilitate gripping of the tube 10 by the wrapping tool 20 (Spec. 3-4, ¶ 23 and figs. 1-3). The contour 310 can be continuous including a trough 312 and bearing surfaces 314 (Spec. 4, ¶ 24 and figs. 3 and 5). The contour 310 can also be discontinuous including holes 322 and bearing surfaces 324 (Spec. 4, ¶ 25 and figs. 4 and 6).

Claims 1 and 10 are illustrative of the claimed invention and read as follows:

1. A tube for containing a product to be squeezed from the tube when the tube is used in conjunction with a wrapping tool, the tube comprising:
 - a deformable main body for storing the product prior to the product being squeezed from the tube, the main body having a longitudinal direction, a transverse direction perpendicular to the longitudinal direction, a first end and a second end opposite the first end in the longitudinal direction of the main body;
 - an opening at the first end of the main body, the opening being an outlet for the product when the product is squeezed from the tube; and
 - a seal at the second end of the main body and formed solely by the main body, the seal having a contour, the contour having a bearing surface that is non-parallel to the longitudinal direction of the main body,

wherein the bearing surface is for receiving a wrapping force from the wrapping tool for wrapping the main body around the seal.

10. A tube for containing a product to be squeezed from the tube when the tube is used in conjunction with a wrapping tool, the tube comprising:

a deformable main body for storing the product prior to the product being squeezed from the tube, the main body having a longitudinal direction, a transverse direction perpendicular to the longitudinal direction, a first end and a second end opposite the first end in the longitudinal direction of the main body;

an opening at the first end of the body, the opening being an outlet for the product when the product is squeezed from the tube; and

a seal at the second end of the main body and formed solely by the main body, the seal having a contour, the contour having a bearing surface that is non-parallel to the longitudinal direction of the main body,

wherein the bearing surface is for receiving a wrapping force from the wrapping tool for wrapping the main body around the seal, and the bearing surface is discontinuous along the transverse direction of the main body.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Bolz	US 1,884,543	Oct. 25, 1932
Young	US 2,633,270	Mar. 31, 1953

The following rejections are before us for review:

Claims 1-22 stand rejected under 35 U.S.C. § 112, first paragraph for failure to comply with the written description requirement.

Claims 1-8 and 18-21 stand rejected as being anticipated under 35 U.S.C. § 102(b) or, in the alternative, as unpatentable under 35 U.S.C. § 103(a) over Young.

Claims 1, 10-17, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Bolz.

The Examiner provides reasoning in support of the rejections in the Answer (mailed April 11, 2007). The Appellants present opposing arguments in the Appeal Brief (filed December 27, 2006) and the Reply Brief (filed June 11, 2007).

OPINION

The lack of written description rejection

We first consider the Examiner's rejection of claims 1 through 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner takes the position that the limitation of claims 1 and 10 calling for a seal to be “formed solely by the main body” is not adequately supported in the disclosure as originally filed (Ans. 3).¹ The Appellants argue that the Drawings show that “no additional materials or components other than the main body are used to create the

¹ This limitation, not contained in the claims at the time the application was filed, was added to claims 1 and 10 in an amendment filed July 28, 2005 with the request for continued examination.

seal” (App. Br. 5). At the outset, we note that the Appellants have not identified, nor can we find, disclosure in the Specification that the seal is “formed solely by the main body.” Nevertheless, the absence of a recited term in the Specification is not dispositive so long as the disclosure reasonably supports the limitation. To satisfy the written description requirement, the disclosure must convey with reasonable clarity to skilled artisans that the Appellants were in possession of the claimed invention as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Therefore, the issue before us is whether the disclosure reasonably supports this recited limitation.

The subject matter of claims 1 through 22 encompasses more than one embodiment of the Appellants’ claimed invention. Specifically, we find that claims 1-4 and 18-21 are drawn to a tube having a continuous contour as shown in Figures 1-3 and 5 of the Appellants’ drawings. As shown in Figures 7-12 of the Appellants’ drawings, claims 5-9 are drawn to a tube 10 having a main body 100 and a seal 300 with a thickened portion 330 or thickened portions 340. Finally, claims 10-17 and 22 are drawn to a tube having a discontinuous contour, as shown in Figures 4 and 6 of the Appellants’ drawings. We agree with the Appellants that the drawings of the instant application can be relied upon to show that the Appellants were in possession of the claimed invention as of the filing date. *See Vas-Cath*, 935 F.2d at 1563-64 (“[D]rawings alone may be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.”) However, contrary to the Appellants’ position, as discussed more fully below, we do not find that the drawings in the instant application support the limitation of

the seal being “formed solely by the main body” for all disclosed and claimed embodiments of the invention.

Specifically, we find that Figures 1-3 and 5 convey with reasonable clarity to one ordinarily skilled in the art that the seal is “formed solely by the main body.” In the side view of seal 300, presented in Figure 3, a continuous line is used to show main body 100 and seal 300. Similarly, in the three-dimensional view of Figure 5, each of the illustrated longitudinal side edges of the main body 100 and the seal 300 is represented by a continuous line. We find that the longitudinal line above the reference number “100” is used to merely indicate a change in the curvature radius where the walls of main body 100 converge together to form seal 300. Therefore, we find that Figures 1-3 and 5 convey with reasonable clarity to one ordinarily skilled in the art that the seal is “formed solely by the main body,” thus providing support for the subject matter of claims 1-4 and 18-21. Hence, the rejection under 35 U.S.C. § 112, first paragraph is reversed as to claims 1-4 and 18-21.

Claims 10-17 and 22 require the seal to have a contour having a bearing surface that is non-parallel to the longitudinal and discontinuous along the transverse direction of the main body. These claims are directed specifically to the embodiment illustrated in Figures 4 and 6. We note that Figure 6, in contrast to Figure 5, does not depict the right longitudinal edge of the main body 100 and seal 300 as a continuous line. Rather, the right longitudinal edge appears to jut outwardly at the junction of the seal 300 portion, hence suggesting that seal 300 is a portion that is separate from the main body 100. In conclusion, we find that Figure 6 does not clearly convey to one ordinarily skilled in the art a seal that is “formed solely by the main

body.” Therefore, the rejection under 35 U.S.C. § 112, first paragraph is sustained as to claims 10-17 and 22.

Claims 5-9 require that the contour of the seal comprise a first thickened portion of the seal and are thus directed specifically to the embodiments illustrated in Figures 7-12. The line drawn between the thickened portion 330 (or portions 340) and seal 300 suggests that the additional thickened portion is formed at least in part by structure that is distinct from the main body 100. Hence, we find that Figures 7-12 do not clearly convey that the seal is “formed solely by the main body.” Therefore, the rejection under 35 U.S.C. § 112, first paragraph is also sustained as to claims 5-9.

The anticipation rejection based upon Young

Young discloses a winding key 33 (wrapping tool) for a dispensing tube for storing a product to be squeezed from the dispensing tube (col. 1, ll. 4-8 and fig. 7). The dispensing tube includes a body 32, a dispensing end 34 (opening), and a seal 31 that engages with key 33 (col. 3, ll. 35-42 and figs. 7 and 8). Furthermore, the key 33 includes projections at points 27, 28, and 29 that allow improved engagement between the key 33 and the tube end (col. 2, ll. 50-53; col. 3, ll. 30-34; and figs. 8, 10, and 11). The Appellants argue that Young does not teach a seal being “formed solely by the main body” (underlining added) (App. Br. 7). In response, the Examiner contends that the limitation of the seal being “formed solely by the main body” is a product-by-process limitation and as such should not be given patentable weight because the Appellants’ claimed invention is drawn to a product (Ans. 3). We disagree with the Examiner. The use of the word

“formed” does not imply a product-by-process limitation, as the Examiner contends, but rather a structural limitation, namely, that no additional structure, distinct from the main body, forms or makes up any portion of the seal. Therefore, we find that the Examiner erred in not giving patentable weight to the limitation of the seal being “formed solely by the main body.”

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Young does not disclose a seal being “formed solely by the main body.” On the contrary, Young specifically discloses a seal that is not “formed solely by the main body,” but rather is a component 31 that is distinct from the main body 32 (figs. 10 and 11). We therefore agree with the Appellants that Young does not disclose all the limitations of claim 1. As such, the rejection of claim 1, and claims 2-8 and 18-21 that depend from claim 1, is reversed.

The anticipation rejection based upon Bolz

Bolz discloses a collapsible tube 1 for storing a product to be squeezed from the tube using a key 20 (wrapping tool). The tube includes a body, a dispensing end covered by a cap 2 (opening), and a seal formed by a metal strip 13 that engages with key 20 (page 1, ll. 41-60 and figs. 1 and 8). The Appellants argue that Bolz does not teach a seal being “formed solely by the main body” (underlining added) (App. Br. 11-12). In response, the Examiner contends that the limitation of the seal being “formed solely by the main body” is a product-by-process limitation and as such should not be given patentable weight because the Appellants’ claimed

invention is drawn to a product (Ans. 4). We disagree with the Examiner. As discussed above, the use of the word “formed” does not imply a product-by-process limitation, as the Examiner contends, but rather a structural limitation, namely, that no additional structure, distinct from the main body, forms or makes up any portion of the seal. Therefore, we find that the Examiner erred in not giving patentable weight to the limitation of the seal being “formed solely by the main body.” Bolz does not disclose a seal being “formed solely by the main body.” On the contrary, Bolz specifically discloses a seal that is not “formed solely by the main body,” but rather is a strip 13 that is distinct from the main body of tube 1 (figs. 1 and 2). We therefore agree with the Appellants that Bolz does not disclose all the limitations of claims 1 and 10. As such, the rejection of claims 1 and 10, and claims 11-17 and 22 that depend from claim 10, is reversed.

The obviousness rejections based upon Young and upon Bolz

The issue presented in the appeal of the obviousness rejections is whether the Appellants have demonstrated that the Examiner erred in determining that claims 1-8 and 18-21 are unpatentable over Young or that claims 1, 10-17, and 22 are unpatentable over Bolz. The issue turns on whether the Examiner has established a prima facie case that it would have been obvious for one of ordinary skill in the art to provide a seal being “formed solely by the main body” on the dispensing tube of Young or the tube of Bolz.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is

patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

The Examiner asserts that it would have been obvious for one of ordinary skill in the art “to make the seal formed solely by the main body in order to form a more permanent bond and thus, lower the risk of detachment of the seal from the body” (Ans. 4). However, the Examiner has not provided any factual basis to show either that a seal “formed solely by the main body,” as opposed to the seal 31 of Young or the strip 13 of Bolz, necessarily creates a “more permanent bond” or that a person of ordinary skill in the art would understand this to be the case. In the Appellants’ invention, a seal “formed solely by the main body” creates a bond between the end surfaces of the main body. Similarly, the seal 31 of Young and the strip 13 of Bolz are used to create a bond between the ends of the tube. We note that the strength of a seal depends on a variety of factors, such as the material(s) bonded together, the type of bond formed,² and the process used to form the bond. Without taking these factors into consideration, we find that it is not clear that a seal “formed solely by the main body” necessarily creates a “more permanent bond” than the seal 31 of Young or the strip 13 of Bolz, as the Examiner contends. Furthermore, in addition to bonding the surfaces of the tube, the seal of Young must also assure structural integrity of the bond when the projections present on the key engage the end of the tube. Therefore, we find that one ordinarily skilled in the art would

² We note, for example, that a chemical bond between two dissimilar materials may, under certain circumstances, be stronger and more permanent than a mechanical bond between like materials.

understand that the seal of Young must be substantially rigid in order to be able to provide bonding of the tube while also providing structural integrity to the bonded surfaces when the key projections engage the tube during the winding of the key and dispensing of the product from the tube. The skilled artisan would likewise understand that the strip 13 of Bolz must be substantially rigid in order to provide bonding of the tube while also providing structural integrity when the arched finger 18 of key 20 engages the apertures 16 of ear extensions 15. We do not find that the Examiner has established a factual basis either that a seal formed “solely by the main body” in the tube of Young or Bolz would provide the required structural integrity in addition to the bonding of the ends of the tube or that a person of ordinary skill in the art would understand this to be the case. As such, the rejections of claim 1, and claims 2-8 and 18-21 that depend from claim 1, as unpatentable over Young and claims 1 and 10, and claims 11-17 and 22 that depend from claim 10, as unpatentable over Bolz are reversed.

SUMMARY

The Examiner’s rejection under 35 U.S.C. § 112, first paragraph for failure to comply with the written description requirement is reversed as to claims 1-4 and 18-21 and affirmed as to claims 5-17 and 22.

The decision of the Examiner to reject claims 1-8 and 18-21 under 35 U.S.C. § 102(b) or, in the alternative, as unpatentable under 35 U.S.C. § 103(a) over Young is reversed.

The decision of the Examiner to reject claims 1, 10-17, and 22 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Bolz is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833